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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,763	01/21/2005	Bernd Rudiger Stober	W1.1931 PCT-US	4037

7590 08/14/2006

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EXAMINER

AKANBI, ISIAKA O

ART UNIT	PAPER NUMBER
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2877

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SPK

Office Action Summary	Application No.	Applicant(s)	
	10/521,763	STOBER, BERND RUDIGER	
	Examiner	Art Unit	
	Isiaka O. Akanbi	2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>21 January 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Amendment

The preliminary amendment file 21 January 2005 has been entered into this application. Claims 1-13 are cancelled. Claims 14-27 have been added.

Information Disclosure Statement

The information disclosure statement file 21 January 2005 has been entered and reference considered by the examiner.

Drawings

The examiner approves the drawings filed 21 January 2005.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25 and 27 are rejected under 35 U.S.C. 101 the claimed invention is directed to non-statutory subject matter.

Claim 25 recites the limitation "using said first and said second reflected inspection lights and said third passed through inspection light for simultaneously and separately performing two incident light inspections and one transmitted light inspection on said material". Merely using said first and said second reflected inspection lights and said third passed through inspection light for simultaneously and separately performing two incident light inspections and one transmitted light inspection on said material would not appear to be sufficient to constitute a tangible result, since the outcome of the using step has not been used in a disclosed practical application nor made available in such a manner that's it's usefulness in a disclosed practical application can be realized. See OG Notices: 22 November 2005, "Interim Guidelines for

Examination of Patent Applications for Patent Subject Matter Eligibility". Claim 27 is rejected to as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto et al. (6,064,477).

As regard to claims 14 and 25, Matsumoto discloses a device/method for inspecting material comprising of the following:

a sensor device (51/551), an illumination device (2/20/3/30), at least first and second light sources (21/201/31/301) in said illumination device, a first inspection light of a first color emitted by said first light source, and a second inspection light of a second color emitted by said second light source, said first and second colors being different (col. 7, line 30-47)(col. 8, line 46-50), at least first and second color channels in said sensor device (51/551), each of said at least first and second color channels being matched to said first and second inspection lights emitted from said first and second light sources, said at least first and second color channels receiving said first and second inspection lights that are at least one of passed through and reflected by the material (col. 21, line 35-38) and an evaluation device (54) adapted to process image content of each of said at least first and second color channels (figs. 1, 23, 24 and 25)(col. 20, line 25-42).

As to claim 15, according to claim 14, Matsumoto discloses wherein said at least first and second inspection lights emitted by said at least first and second light sources (21/201/31/301) of said illumination device (2/20/3/30), after one of passing through and being reflected by the material (col. 21, line 35-38), are recorded together (4) by said sensor device and separately (5)(52/552) evaluated in said evaluation device (col. 20, line 25-42).

As to claim 16, Matsumoto discloses wherein each of said at least first and second inspection lights are each a substantially monochrome light color (col. 16, line 59-61).

As to claim 17, Matsumoto discloses wherein at least one of said spectral position and bandwidth of each said inspection light is matched to a transmission curve of said sensor device (col. 5, line 66-col. 6, line 1-14).

As to claims 18 and 19, Matsumoto discloses wherein said sensor device is a color line camera and wherein said sensor device is a CCD camera (col. 29, line 34-col. 30, line 1-37).

As to claim 20, Matsumoto discloses wherein said sensor device (51/551) has first, second and third color channels (col. 5, line 66-col. 6, line 1-10) wherein said illumination device (2/20/3/30) has first, second and third light sources (21/201/31/301) and wherein each first, second and third light sources emit first, second and third inspection lights matched to properties of said first, second and third color channels (col. 6, line 60-col. 7, line 1-2).

As to claims 21 and 22, Matsumoto discloses wherein said at least first and second light sources (21/201/31/301) are arranged at first and second different positions relative to the material and wherein said at least first and second light sources are each displaceable (figs. 1 and 35).

As to claims 23 and 24, Matsumoto discloses wherein at least one of said at least first and second inspection lights passes through the material and another of said at least first and second inspection lights is reflected by the material and wherein at least one of said at least first and second inspection lights is reflected by the material at a first angle and at least a second of said at least first and second inspection lights is reflected by the material at a second angle (col. 20, line 25-42)(col. 7, line 57-col. 8, line 1-9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (6,064,477).

As to claims 26 and 27, Matsumoto discloses the claimed invention, as applied to claim 14 and 25 except for is silent regarding the material is a printed product including image information and providing the material as a printed product including image information. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987).

Additional Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed in the attached form PTO-892 teach of other prior art device/method for inspecting material that may anticipate or obviate the claims of the applicant's invention.

Conclusion

Fax/Telephone Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isiaka Akanbi whose telephone number is (571) 272-8658. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley Jr. can be reached on (571) 272-2059. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isiaka Akanbi
July 24, 2006



**HWA (ANDREW) LEE
PRIMARY EXAMINER**